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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,790	01/12/2001	David L. Benson	P04810US0 PHI 1317	2855
27142	7590	11/05/2003		
			EXAMINER	
			MEHTA, ASHWIN D	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n No.</b>	<b>Applicant(s)</b>	
	09/759,790	BENSON, DAVID L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ashwin Mehta	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 21 July 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-8,20,44-54,56,57,60-63 and 66 is/are pending in the application.

4a) Of the above claim(s) 44-51, 57, and 66 is/are withdrawn from consideration.

5) Claim(s) 1-6,53,54 and 56 is/are allowed.

6) Claim(s) 7,8 and 60-63 is/are rejected.

7) Claim(s) 20 and 52 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2003 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The objection to the specification for the presence of blank lines on page 7 is withdrawn, in light of the amendment of the relevant paragraph.

4. The rejection of claims 45-51, 59, and 64 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, is withdrawn.

5. The rejection of claims 44-51, 56, 57, and 59 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, is withdrawn.

6. The rejection of claims 48-51 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, is withdrawn.

7. The rejection of claims 58 and 59 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, is withdrawn.

***Election/Restrictions***

8. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, 20, 52-54, 56, 57, and 60-63, drawn to hybrid maize seed designated 34B97; a maize plant or its parts produced from said seed; a tissue culture of regenerable cells of said plant; a maize plant regenerated from said tissue culture; said maize plant further comprising an introgressed cytoplasmic gene that confers male sterility; said hybrid maize plant wherein the genetic material contains one or more mutant genes or transgenes; a method of making hybrid maize plant 34B97 comprising crossing inbred maize plants GE533003 and GE5567919; a method of producing a male sterile maize plant comprising transforming 34B97 with a transgene conferring male sterility, classified in class 800, subclass 320.1, for example.
  - II. Claims 44-51, 57, and 66, drawn to methods of developing a transgenic 34B97 maize plant comprising transforming at least one of the inbred parents of 34B97 with a transgene; or a method of developing a backcross conversion of 34B97 hybrid maize plant, comprising backcrossing a mutant gene or transgene into at least one of two inbred maize plants; a maize plant produced by said methods; a process for isolating an inbred corn plant, classified in class 800, subclass 260, for example.

Claims 44-51, 57, and 66 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to methods that involve introgressing or transforming a gene into at least one of the parents of hybrid plant 34B97 and then crossing those plants, and the plant produced from that cross. The methods and products of Group I do not encompass introducing genes into the inbred parent plants of 34B97. Further, the methods of Group II produce plants that are distinct from hybrid maize plant 34B97.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Since Applicant has received an action on the merits for the originally presented invention, Group I, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-51 and 66 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### *Claim Objections*

9. Claims 20 and 52 are objected to under 37 CFR 1.75 (b) as being duplicate claims. Both claims are directed to the same maize plant. Applicant is required to cancel one of the claims, or amend the claim(s).

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

10. Claim 8 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses the rejection in the paper filed July 21, 2003. Applicant's arguments have been fully considered but were not found persuasive.

Applicant argues that the claim amendment alleviates the rejection (response, page 10, 2<sup>nd</sup> full paragraph). However, the amendment causes the claim to have a broader scope than the claim from which it depends. The plant of claim 2 does not comprise an introgressed cytoplasmic gene conferring male sterility.

11. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation, "capable of expressing" renders the claim indefinite. It is not clear if the claimed plant actually expresses the traits, or when or under what conditions the traits are expressed. It is suggested that the recitation replaced with --having--.

12. Claims 60-63 remain and claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office action mailed May 19, 2003

under item 7. Applicant traverses the rejection in the paper filed July 21, 2003. Applicant's arguments have been fully considered but were not found persuasive.

Applicant again argues that the claims have been amended to be in a format indicated as allowable by claims that were supposedly faxed to Applicants by Supervisory Patent Examiner Amy Nelson and Examiner David Fox (response, page 11, 5<sup>th</sup> full paragraph). However, this claim format was not faxed or suggested by SPE Nelson or Examiner Fox. Applicant argues that claim 60 is described on page 5, first full paragraph, of the specification (response, page 11, 5<sup>th</sup> full paragraph). However, the specification does not describe any seeds derived from selfing or sibbing hybrid plant 34B97. As these products are not described, the method is not described.

See 64 Fed. Reg. 71427, 71428 (1999), comment No. 4.

Applicant also argues that the written description guidelines, in 66 Fed. Reg. 1099, Vol. 66, No. 4, (January 5, 2001) state that an old process performed with a novel material is novel in and of itself, and that therefore the claimed invention is described. Applicant also directs attention to Example 10 of the Written Description Guidelines Training Material (response page 11, 5<sup>th</sup> full paragraph). However, whether or not a method is novel is not the issue here. The rejection does not discuss the novelty of the claimed invention. It is also noted that in Example 10 of the Training Material, all of the products required for the claimed process are described. In instant claim 60, the self or sib pollinated seed and the successive filial generations are not described.

Regarding claim 8: the specification does not describe hybrid maize seed 34B97 as comprising a cytoplasmic gene that confers male sterility. The specification does not describe how any gene can be introgressed into any hybrid corn plant.

13. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim is broadly drawn towards a maize plant produced from hybrid maize seed designated 34B97, said plant further comprising an introgressed cytoplasmic gene the confers male sterility.

The specification indicates that backcrossing to transfer specific desirable traits into an inbred line (paragraph bridging pages 3-4). The specification also indicates that pedigree breeding involves inbred lines (page 5).

However, 34B97 is a hybrid plant. The specification does not teach how a gene can be introgressed into any hybrid plant. As crossing two different inbred corn plants produces 34B97, it is not clear how crossing 34B97 with another plant, and then using 34B97 as a recurrent parent can produce the claimed plants. Examples of introgressing a gene or trait into a hybrid plant are lacking in the relevant prior art. In the absence of further guidance, undue experimentation would be required by one skilled in the art to introgress one or more genes into hybrid maize plant 34B97. See Genentech, Inc. V. Novo Nordisk, A/S, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997), which teaches that “the specification, not the knowledge of one skilled in the art” must supply the enabling aspects of the invention.

14. Claims 1-6, 53, 54, and 56 are allowed. Claims 7, 8, and 60-63 are rejected. Claims 20 and 52 are objected to. Claims 44-51, 57, and 66 are withdrawn from consideration.

***Contact Information***

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

October 29, 2003



Ashwin D. Mehta, Ph.D.  
Primary Examiner  
Art Unit 1638